

### **III. REMARKS**

Claims 1-10 are pending in this application. By this response, claims 1, 3 and 6-10 have been amended. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

#### **35 U.S.C. 112**

In the Office Action, claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Office Action, p. 2. In response, Applicants submit that the claimed “media player” is definite and properly limits the scope of Applicants “system” in claim 6. MPEP 2173.04 states that “breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.” Accordingly, Applicants submit that all claims are definite and respectfully request withdrawal of the rejection.

## 35 U.S.C. 101

In the Office Action, claims 3 and 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully request withdrawal of the rejection in light of the following remarks.

With respect to claims 6 and 8, the Office asserts that the respectively claimed “media player” and “system” claim limitations appear to be directed to a computer program *per se*. Office Action, p. 3 and p. 5. In response, Applicants have amended claim 6 to include, *inter alia*, at least one processor for presenting a document. Thus, the “system” language in claim 6 can no longer be construed as a computer program *per se*, since claim 6 now recites that the system includes at least one processor. Applicants submit that claim 6 is statutory and respectfully request withdrawal of the rejection. Claims 7-9 depend from claim 6. Accordingly, Applicants herein incorporate the arguments presented above with respect claim 6 from which the claims depend. The dependent claims are believed to be statutory based on the above arguments, as well as for their own additional features. That is, with regard to claim 8, since “system” according to claim 6 can no longer be construed as a computer program *per se*, the same applies to a media player comprising the system.

With respect to claims 3, 7 and 9, the Office asserts that the claimed “information carrier” is non-statutory because it appears to be a carrier wave, a form of electromagnetic energy. Office Action, p. 3. In response, Applicants submit that claims 7 and 9 depend from statutory independent claim 6. Accordingly, Applicants herein incorporate the arguments presented above with respect to independent claim 6 from which claims 7 and 9 depend and respectfully request withdrawal of the rejection based on at least the arguments presented above.

Furthermore, with respect to the rejection of claim 3, it is noted that claim 3 depends from claim 1. Claim 1 is deemed to be statutory because it recites a method comprising a number of steps for achieving a useful, concrete (i.e., reproducible) and tangible result. Since claim 1 was not rejected, it is deemed that the Office agrees that claim 1 is statutory. Because claim 3 depends from claim 1, it recites essentially the same steps by virtue of its dependency, and it is axiomatic that claim 3 is statutory for the same reasons that claim 1 is statutory.

Applicants respectfully submit that the Office's *per se* rejection of claim 3 based on the mere incidental recitation of an "information carrier" in claim 3 (as also applicable to claim 1 now in view of claim 1 now also including an "information carrier") is not sufficient grounds for rejection under 35 U.S.C. 101. The Office has the burden of establishing *prima facie* that the method claimed does not produce a useful, concrete and tangible result. The Office has not explained why the method claimed in claim 3 does not produce a useful, concrete and tangible result and therefore, has not carried its burden. On the contrary, claim 3 includes the same method steps as claim 1 by virtue of dependency. Since claim 1 was not rejected, and apparently is believed by the Office to produce a useful, concrete and tangible result, it is axiomatic that claim 3 also produces a useful, concrete and tangible result, and is thereby statutory.

It is noteworthy that applicants are not only claiming an information carrier. Rather, the claimed information carrier is recited as an incidental element with respect to the remainder of a number of claimed steps, which apparently have not been factored into the Office's analysis. The Office is reminded that the test under 35 U.S.C. 101 is directed to whether a claim as a whole is statutory, not whether a single element in the claim is statutory. The fact that some element in the claim is incidentally an "information carrier" does not necessarily make the claim as a whole non-statutory. As a whole, claim 1 is directed to a statutory method.

Furthermore, the Office cites the following passage:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism *per se*, and as such are nonstatutory natural phenomenon. (Emphasis added.)

Applicants respectfully submit that the presently rejected claims are distinguishable. The Office's position appears to be that the recitation of the "information carrier" alone makes claims 3, 7 and 9 *per se* non-statutory. However, the Office's cited passage makes clear that in order for a claim to be nonstatutory, the claim has to recite "nothing but the physical characteristics of a form of energy..." The Office cannot reject claim 3, for example, as non-statutory based only on the claimed "information carrier", as this reasoning does not satisfy the requirement that the claims recite "nothing but the physical characteristics of a form of energy..." Claim 3 recites more than just an "information carrier". Claim 3, by virtue of dependency from claim 1, recites, *inter alia*, a number of method steps, which the Office has not designated as "nothing but the physical characteristics of a form of energy..." By not rejecting claim 1, the Office must believe that the method steps of claim 1 (which are included in claim 3) are more than just "physical characteristics of a form of energy..."

In addition, it is well-settled that although, for example, a law of nature or mathematical algorithm, by itself, may be non-statutory, "an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection". *Diamond v. Diehr*, 450 U.S. 175, 187 (1981). Likewise, although the Office may consider an "information carrier" to be non-statutory by itself, the application of the information carrier to the claimed process and claimed steps is deserving of patent protection.

Next the Office cites the following passage:

Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in §101.

Again, the presently rejected claims are distinguishable from the cited passage. The cited passage, in the proper context refers to a situation where a signal is the main subject of the claim (i.e., the applicant claims a pure signal comprising various features). By stark contrast, the claimed “information carrier” is incidental to the main subject matter of the claim, which involves a variety of steps for presenting a document. This distinction is more clearly explained in the next passage cited by the Office, which refers to a claimed signal as “clearly not a “process” under §101 because it is not a series of steps.” That is, the passages cited by the Office are directed to a situation where the main subject matter of the claim is purely a signal, not a series of steps. By stark contrast, claim 1 recites “a method comprising” a “requesting” step, a “determining” step, and a “presenting” step (i.e., a series of steps). That is, claim clearly recites a process because it recites a series of steps. Hence, the Office’s cited passage supports claim 3 as statutory under the “process” category of statutory subject matter.

The remaining cited passages are not applicable as they are directed to machines, composition of matter, and articles of manufacture, and rejected claim 3 is directed to a method comprising a series of steps. Accordingly, independent claim 1, and dependent claim 3 are deemed statutory and patentable.

Claims 7 and 9 are also deemed statutory as the Office has not shown that these claims as a whole are non-statutory, but merely relies on the incidental recitation of an “information carrier” as the reasoning for the rejection. Thus, the arguments made with respect to claim 3 above, apply to claims 7 and 9. That is, the main subject of matter of the rejected claims, and the

rejected claims as a whole are statutory, despite the “information carrier” being incidentally recited.

With respect to claim 10, the Office asserts that the claimed “computer program product” appears to be a computer program per se. Office Action, p. 5. Specifically, the Office asserts that the computer program is not embodied in a computer readable medium, and is thus not statutory. In response, Applicants have amended claim 10 to recite, *inter alia*, “computer-executable program product embodied on a computer readable medium for enabling a computer to perform the method according to claim 1.” Thus, the system of claim 10 is embodied in a computer readable medium. Applicants submit that claim 10 is statutory and respectfully request withdrawal of the rejection.

In light of the above, Applicants believe that all grounds of the §101 rejection have been obviated. Accordingly, Applicants submit that claims 1-10 each recites statutory subject matter.

## **35 U.S.C. 102**

In the Office Action, claims 1-3, 5-6, 8 and 10 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Himmel et al. (U.S. Pat. No. 6,208,995), hereinafter “Himmel.” In response, Applicants submit that Himmel fails to disclose each and every element of claim 1, including, “determining if the document is present within a sub-collection of the collection, the sub-collection comprising those documents, of the collection of documents, that are allowed to be presented to the user, wherein the sub-collection of the collection is determined based on an application located on an information carrier.” (See claim 1, and as similarly recited by claim 6.) Specifically, Applicants submit that Himmel fails to disclose, *inter alia*, determining the sub-collection of the collection based on an application located on an information carrier.

Interpreting Himmel only for the purposes of this response, Applicants submit that Himmel merely teaches that “bookmark sets allow the user to create specific sets of URLs depending on his or her needs. For example, a privileged user can configure an Office bookmark set to satisfy each of the environments and users of the browser.” Col. 7, lines 23-27. As such, each bookmark set in Himmel is determined simply based on user/administrator preference. The bookmark set may then be made available on a website and/or webserver for other users to download. Col. 13, lines 30-50. However, Himmel fails to determine a sub-bookmark list based on an application located on an information carrier. Instead of simply creating a list of active and inactive bookmarks based on the preferences of an administrator/parent, as disclosed by Himmel, claim 1 recites determining the sub-collection based on an application located on the information carrier. Accordingly, Applicants submit that Himmel fails to disclose each and every element of claim 1 and respectfully request withdrawal of the rejection. Since similar amendments have been made to independent claim 6, withdrawal of the rejection of that claim is also requested.

With respect to all of the dependent claims, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

### **35 U.S.C. 103**

In the Office Action, claims 4, 7 and 9 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Himmel in view of Metz (U.S. Patent No. 5,768,539). Applicants herein incorporate the arguments presented above with respect to the independent claims from which

the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

#### **IV. CONCLUSION**

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. If the Examiner believes that anything further is necessary to place the application in condition for allowance, the Examiner is requested to contact Yan Glickberg at the telephone number listed below.

Respectfully submitted,

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